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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,393	06/18/2001	Manoel Tenorio	020431.0846	3582
7590 07/06/2004				
Christopher W. Kennerly Baker Botts L.L.P. Suite 600 2001 Ross Avenue Dallas, TX 75201			EXAMINER HAQ, NAEEM U	
			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/884,393

Applicant(s)

TENORIO, MANOEL

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 22 is objected to because of the following informalities: This claim recites a series of steps under a "means for:" heading. The proper format for invoking 112, 6<sup>th</sup> paragraph is to recite the phrase "means for" for each particular limitation. See MPEP 2181. Appropriate correction is required.

Claims 23, 24, and 25 recite the limitation "the specified number of merged search results" in the second limitation of the claims. There is insufficient antecedent basis for this limitation in the claims because the search results are not merged until later in the claims, i.e. the fourth limitation. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-14 and 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims make only nominal use of technology and are therefore not within the technological arts. Ex parte Bowman requires non-trivial recitation of technology in the body of the claim language. In the present case, claims 1-14 and 22-24 do not recite any technology in the body of the claims. Indeed the steps of these claims can be

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performed by hand and do not require any technology whatsoever. Although the claims do recite the term "database", the use of this term does not constitute a technological recitation since the database could be a physical database (e.g. a folder in a cabinet). Therefore, these claims are deemed to be not within the technological arts.

*The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001)).* Although Bowman is not precedential, it has been cited for its analysis.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 and 23 are system claims. However, these claims recite a process for a method and not structural elements of a system. Therefore it is unclear to the examiner how the process limitations of these claims affect the structural elements of the system. System claims should be directed to the structural elements of a system and not to the process of a method. *"Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function."* *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). *"Apparatus claims cover what a*

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*device is, not what a device does." Hewlett-Packard Co. v Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).*

In addition, independent claims 1, 8, 15, and 22-25 all recite the limitation "...one or more seller databases..." If there were only one seller database then the step of merging the sorted search results would never happen because there is nothing to merge the search result with. For this reason, it is unclear to the Examiner what the scope of the claim is when there is only one seller database.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borchers (US 2002/0147704 A1) in view of Kepler et al. (US 6,745,177 B2) and further in view of Breese et al. (US 6,006,218).**

Referring to claims 1-25, Borchers teaches a system, method and software operable to: communicate a search query to a plurality of databases that contain data, each database operable to generate local search results responsive to the search query (page 1, paragraph [0008] – [0011]; page 2, paragraphs [0016] – [0021]). Borchers also teaches receiving the search results from the databases; merging the search results received from the databases to generate a merged search result (pages 2 and 3,

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paragraph [0021]); sorting the merged results according to a sorting parameter (page 2 and 3, paragraph [0021]). Borchers does not teach that the data is product data or that the database is a seller database. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system, method, or program. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of communicating receiving, merging, and sorting would be performed the same regardless of what information the database contained or what type of database was used. The differences between the Applicant's data/database table and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the database of Borchers because such information does not functionally relate to the elements of the claimed system, method, and program and because the subjective interpretation of information does not patentably distinguish the claimed invention. Borchers also does not teach that the number of merged search results being less than or equal to the product of the specified number and the number of the seller databases to which the search query is communicated. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to limit the search result to any number desired. Applicant has not disclosed that limiting the search result to a number less than or equal to the product of the specified

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number and the number of the seller databases provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with any number of search results greater or equal to one because such a number does not affect or effect the system, method and program in anyway. Therefore, it would have been obvious to one of ordinary skill in this art to modify the teachings of Borchers to obtain the invention as specified in the claims. Borchers does not teach communicating one or more sorting parameters to the seller databases, the sorting parameters directing each seller database to sort the search results generated at each database in response to the search query. However, Kepler teaches this limitation (column 9, lines 5-14; Figure 4). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Kepler into the invention of Borchers. One of ordinary skill in the art would have been motivated to do so in order to create a sorted list of records, as taught by Kepler. Borchers and Kepler do not teach that the sorting parameter further directs the databases to initially communicate no more than a specified number of sorted search results in response to the search query. However, Breese teaches a method of retrieving information form a database wherein the number of search results is limited to fixed number (column 7, lines 18-58). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Breese into the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to protect the user from being overloaded with information. The cited prior art

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does not teach repeating the steps of claims for an additional search request. However, this is an inherent feature in the cited prior art because nothing in the prior art prevents the user from repeating the steps and because the prior art is designed to repeat the steps as many times as required by the user. Furthermore, good programming design would render obvious the need to repeat the steps of the cited prior art as many times as necessary. One of ordinary skill in the art would have been motivated to do so in order to make the most economical use of the cited prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Application/Control Number: 09/884,393

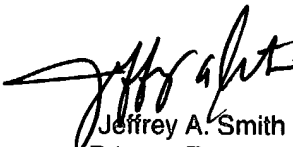
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**Naeem Haq**, Patent Examiner  
Art Unit 3625

June 23, 2004



Jeffrey A. Smith  
Primary Examiner